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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,455	12/15/1998	KYOJI YAMAGUCHI	FJN-070	2918

7590 01/08/2002

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EXAMINER

HAMUD, FOZIA M

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 01/08/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/202,455

Applicant(s)  
Yamaguchi et al

Examiner  
Fozia Hamud

Art Unit  
1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 19, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 69, 80, 82, 84-88, and 90 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 69, 80, 82, 84-88, and 90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 1646

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 December 2001 has been entered.
2. Receipt of Applicant's arguments and amendment filed on 19 December 2001 in Paper No20 is acknowledged. Claims 65-67, 72-79, 81 and 89 have been canceled and claims 69, 80, 82, 84, 85 and 88 have been amended. Thus claims 69, 80, 82, 84, 85-88 and 90 (renumbered to account for number 84 which Applicant inadvertently skipped) are pending and under consideration.
3. The following previous objections and rejections are withdrawn in light of Applicants amendments filed in Paper No.20, 12/19/01:
  - (I) All of the rejection of canceled claims 65-67, 72-79, 81 and 89, because these claims hve been canceled.
  - (ii) The objection to claims 69, 80, 82, 84-86 and 88 for not using a colon after SEQ ID NO is withdrawn.
  - (iii) The rejection of claims 87 and 90 made under U.S.C. § 112, first paragraph is also withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Applicant's arguments filed in Paper No.20, 12/19/01, have been fully considered but were deemed persuasive in part. The issues remaining are restated below.

Art Unit: 1646

***Claim Rejections - 35 U.S.C. § 102***

6. The rejections of claims 69, 80, 82, 88 and 90 under 35 U.S.C. 102(e) as being anticipated by Anderson et al (US Patent 6,017,729) is maintained for reasons of record set forth in the office action mailed on 11/07/00 in Paper NO.13, pages 10-11, and reiterated in the final office action mailed on 19 June 2001 in Paper No:16. In summary:

Anderson et al teach an isolated human nucleic acid molecule encoding an isolated polypeptide that comprises 317 amino acid residues, (see column 2, lines 1-45). The protein disclosed by Anderson et al comprises 317 amino acid in length, has amino acid terminal, cytoplasmic domain, a transmembrane domain and a carboxyl terminal extracellular domain, is prepared in a soluble form or membrane bound form, (see column 2, lines 1-45).

The polynucleotide disclosed by Anderson et al shares 100% identity to the polynucleotide sequence of SEQ ID NO:19 recited in instant claim 80, and encodes a polypeptide which shares 100% identity to the polypeptide of SEQ ID NO:17 recited in instant claims 69 and 88.

Anderson et al reference discloses a nucleotide sequence that shares 100% homology to the nucleotide sequence of SEQ ID NO:6 and 9 of instant application. The polynucleotide disclosed by Anderson et al meets the fragment limitation recited in claims 82, thus anticipating this claim.

***New Rejections necessitated by Applicants' amendment:***

***Claim Rejections - 35 U.S.C. § 112***

Art Unit: 1646

7a. Claims 80, 84-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7b. Claim 80 is vague and indefinite because it appears that the OCIF-binding protein comprises the nucleic acid sequence selected from the group consisting of SEQ ID NO:15, SEQ ID NO:18 and SEQ ID NO:19. However, since these sequences are not amino acid sequences, it is suggested that the claim be amended to recite "An isolated nucleic acid molecule encoding an OCIF-binding protein, said nucleic acid molecule comprising a nucleotide sequence selected from the group consisting of SEQ ID NO:15, SEQ ID NO:18 and SEQ ID NO:19". Appropriate correction is required.

Claims 84-90 are vague and indefinite so far as they depend on claim 80 for the limitation set forth directly above.

### ***Conclusion***

8. Claims 84, 85, 86 and 87 are free of the prior art of record and would be allowable if rewritten in an independent format. Furthermore, nucleic acid molecules comprising the nucleotides sequence set forth in SEQ ID Nos:2, 15 and 18, and polypeptide sequences comprising the amino acid sequence set forth in SEQ ID Nos:1 and 16 are free of the prior art of record.

### ***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8896. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Art Unit: 1646

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud  
Patent Examiner  
Art Unit 1647  
03 January 2002

*Prema Mertz*  
PREMA MERTZ  
PRIMARY EXAMINER